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I hereby certify that this correspondence, including listed enclosures is being electronically transmitted in Portable Document Form (PDF) through EFS-Web via Hyper Text Transfer Protocol to the United States Patent and Trademark Office's Patent Electronic Business Center on:

Dated: 01/22/2010

Signed: Rolf Foy

Attorney Docket No.: 061873-5007-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Ronald M. COOK, *et al.*

Patent No.: 7,635,762

Issued: Dec. 22, 2009

Issued from Application No.: 10/690,806

Filed: Oct. 21, 2003

For: LUMINESCENT METAL ION COMPLEXES

Customer No.: 43850

Confirmation No.: 9431

Examiner: LEWIS, Patrick T.

Art Unit: 1623

**PETITION FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705(d)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the issuance of U.S. Pat. No. 7,635,762 on December 22, 2009, Applicants submit a petition for reconsideration of patent term adjustment (PTA). In this petition, Applicants request the addition of 651 (six hundred and fifty-one) days to the patent term.

For your consideration, enclosed are the following:

1. Fee set forth under 37 CFR 1.18(e) (see Fee Transmittal Form);
2. Statement of the Facts Involved as described in 37 CFR 1.705(b)(2); and
3. Copy of the Patent Term Adjustment History (attached as Exhibit A)

In view of the reasons set forth in the Statement of Facts, Applicants respectfully request that the patent term be corrected by adding 651 additional days to the term of U.S. Pat. No. 7,635,762 for a total of 921 (nine hundred and twenty-one) days.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310.

If the Examiner believes a telephone conference would expedite this request for reconsideration, please telephone the undersigned at 415-442-1000.

Respectfully submitted,



Todd Esker
Reg. No. 46,690

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DB2/21519452.1

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Art Unit: 1623

STATEMENT UNDER 37 C.F.R. 1.705(b)(2)

1. This statement is respectfully submitted in support of the Petition for Patent Term Adjustment Under 37 C.F.R. § 1.705(d) for the above-referenced patent. In view of the following, it is respectfully requested that Patentees be granted a final patent term adjustment of 921 days and not 270 as calculated by the Patent Office.

37 C.F.R. § 1.705 (b)(2)(i)

2. The patent term adjustment indicated in patent no. 7,635,762, issued on December 22, 2009, is 270 days. Applicants believe, based on their understanding of the rules governing patent term adjustment, that this determination is in error, due to the Office's improper interpretation of the PTA provisions as discussed in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008) and affirmed in *Wyeth and Elan Pharma International, Ltd. v. Under Sec. of Commerce for Intellectual Property*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010). Specifically, the Office improperly limited PTA to either the PTA as calculated under 35 U.S.C. § 154(b)(1)(A) or as calculated under 35 U.S.C. § 154(b)(1)(B), but not both. 69 Fed. Reg. 34238 (June 21, 2004). However, as discussed in *Wyeth et al. v. Dudas* and *Wyeth and*

Elan Pharma International, Ltd. v. Under Sec. of Commerce for Intellectual Property, the statute requires that PTA may comprise contributions from both 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B), and the Office's interpretation of the statute was erroneous to the extent that it considered any delays within the first three years after filing the application to "overlap" with delays under § 154(b)(1)(B) after three years from the filing of the application. According to the Court, no delay accumulated within the first three years after the filing date can be said to "overlap" with delays under §154(b)(1)(B), which by definition do not arise until after three years from the filing date. It is respectfully submitted that the correct patent term adjustment under 37 C.F.R. § 1.702, as calculated under the analysis of *Wyeth et al. v. Dudas* and *Wyeth and Elan Pharma International, Ltd. v. Under Sec. of Commerce for Intellectual Property*, is 921 days.

37 C.F.R. § 1.705 (b)(2)(ii)

3. Applicants seek adjustment to the PTA based on the analysis laid out in *Wyeth et al. v. Dudas and Wyeth and Elan Pharma International, Ltd. v. Under Sec. of Commerce for Intellectual Property*, as contrasted with the Office's analysis laid out in 69 Fed. Reg. 34238 (June 21, 2004). Accordingly, the net PTA comprises accumulated PTA arising from both 35 U.S.C. § 154(b)(1)(A) and (B), excluding actual overlap (35 U.S.C. § 154(b)(2)(A)), and deducting any periods of time in which Applicants failed to engage in reasonable efforts to conclude prosecution (35 U.S.C. §154(b)(2)(C)).

A. Applicants do not presently dispute any aspect of the PTA determination other than the issue raised in *Wyeth et al. v. Dudas and Wyeth and Elan Pharma International, Ltd. v. Under Sec. of Commerce for Intellectual Property*. Accordingly, for the purposes of this request to modify PTA, Applicants accept that part of the calculations provided by the USPTO on PAIR (a copy of which is attached as Exhibit A) indicating that there was a delay of 651 days by the USPTO (35 U.S.C. § 154(b)(1)(A)) in sending out the first action, and that Applicant subsequently incurred a delay of 888 days during the course of the prosecution (35 U.S.C. §154(b)(2)(C)).

B. With regard to the "three year guarantee" provisions of 37 C.F.R. §§ 1.702(b) and 1.703(b), the application was filed on October 21, 2003, and thus PTA began to accrue the day after October 21, 2006. The issuance of the patent on December 22, 2009 cut-

off any further accumulation of PTA under 37 C.F.R. § 1.702(b). The period of October 21, 2006 through December 22, 2009 (inclusive) is 1158 days (35 U.S.C. § 154(b)(1)(B)).

C. Under the analysis of *Wyeth et al. v. Dudas and Wyeth and Elan Pharma International, Ltd. v. Under Sec. of Commerce for Intellectual Property*, this 1158 day period under 37 C.F.R. § 1.702(b) is added to the previously calculated (651 - 888) day period based on 37 C.F.R. § 1.702(a). However, the total examination delay must then be reduced by any actual overlap between the two delays. 37 C.F.R. § 1.703(f). Since the delay of 651 days by the USPTO (35 U.S.C. § 154(b)(1)(A)) in sending out the first action ended on October 3, 2006, prior to the invocation of the delay under 35 U.S.C. §154(b)(1)(B) on October 21, 2006, there is no overlap between the two delays.

D. The resulting PTA is $(651 - 888) + 1158 = 921$ days.

E. Accordingly, Applicants request that the calculated 270 day PTA be adjusted to **921 days**.

37 C.F.R. § 1.705 (b)(2)(iii)

4. The present application is not subject to a Terminal Disclaimer.

37 C.F.R. § 1.705 (b)(2)(iv)

5. Circumstances set forth in 37 C.F.R. § 1.704 are described in Section 3(A) of this paper and in the attached printout of the Patent Term Adjustments tab from PAIR.

In view of the foregoing, it is respectfully requested that this Petition for Patent Term Adjustment Under 37 C.F.R. § 1.705(d) be favorably considered and that a corrected determination of Patent Term Adjustment be issued to reflect a PTA of 921 days.

Respectfully submitted,



Todd Esker
Reg. No. 46,690

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DB2/21519458.1

EXHIBIT A

10/690,806 LUMINESCENT METAL ION COMPLEXES

01-20-
2010:17:31:24**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/690,806

Filing or 371(c) Date:	10-21-2003	USPTO Delay (PTO) Delay (days):	1158
Issue Date of Patent:	12-22-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	888
Post-Issue Petitions (days):	+0	Total PTA (days):	270
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
12-02-2009	PTA 36 Months	507	
12-22-2009	Patent Issue Date Used in PTA Calculation		
11-12-2009	Dispatch to FDC	↑	
11-12-2009	Application Is Considered Ready for Issue	↑	
11-09-2009	Issue Fee Payment Verified	↑	
11-09-2009	Issue Fee Payment Received	↑	
08-24-2009	Sequence Forwarded to Pubs on Tape	↑	
08-10-2009	Mail Notice of Allowance	↑	
08-04-2009	Document Verification	↑	
08-04-2009	Notice of Allowance Data Verification Completed	↑	
07-31-2009	Examiner's Amendment Communication	↑	
07-29-2009	Examiner Interview Summary Record (PTOL - 413)	↑	
07-22-2009	Date Forwarded to Examiner	↑	
06-09-2009	Response to Election / Restriction Filed		827
05-28-2009	Mail Notice of Informal or Non-Responsive Amendment		↑
12-10-2008	Miscellaneous Incoming Letter		↑
04-16-2008	Miscellaneous Incoming Letter		↑
03-06-2009	Date Forwarded to Examiner		↑
03-05-2007	Informal or Non-Responsive Amendment after Examiner Action		↑
03-05-2007	Response to Election / Restriction Filed		61
03-05-2007	Request for Extension of Time - Granted		↑
10-03-2006	Mail Restriction Requirement	651	
09-28-2006	Requirement for Restriction / Election		↑
11-19-2004	Information Disclosure Statement considered		↑
09-06-2006	Fee Payment Recorded (fees filed separately e.g. not with original papers, etc).		↑
09-19-2006	Case Docketed to Examiner in GAU		↑
09-19-2006	Application Return from OIPE		↑
09-19-2006	Application Is Now Complete		↑
09-06-2006	Additional Application Filing Fees		↑

A set of symbols and procedures, provided to the PTO on a

09-06-2006	set of computer listings, that describe in	↑
09-14-2006	CRF Is Good Technically / Entered into Database	↑
06-16-2006	SEQUENCE ERRORS	↑
06-16-2006	Additional Application Filing Fees	↑
04-15-2004	Pre-Exam Office Action Withdrawn	↑
06-08-2006	Application Return TO OIPE	↑
11-19-2005	Reference capture on IDS	↑
11-19-2004	Reference capture on IDS	↑
11-19-2004	Information Disclosure Statement (IDS) Filed	↑
11-19-2004	Information Disclosure Statement (IDS) Filed	↑
10-26-2004	IFW TSS Processing by Tech Center Complete	↑
10-26-2004	Correspondence Address Change	↑
10-26-2004	Change in Power of Attorney (May Include Associate POA)	↑
05-18-2004	Case Docketed to Examiner in GAU	↑
04-15-2004	Application Return from OIPE	↑
04-15-2004	Application Return TO OIPE	↑
04-14-2004	Application Dispatched from OIPE	↑
04-15-2004	Application Is Now Complete	↑
04-05-2004	Additional Application Filing Fees	↑
04-05-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑
01-22-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	↑
01-14-2004	Cleared by OIPE CSR	↑
12-09-2003	IFW Scan & PACR Auto Security Review	↑
10-21-2003	Initial Exam Team nn	↑

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